

REMARKS

The Examiner rejected claims 1-20 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant respectfully traverses the rejection. The Examiner specifically points to the phrase "adapted to" in claims 1, 2, 7, 16, 19, and 20 as being vague and indefinite. The Examiner has not explained what about the claims renders them vague and indefinite. The claim limitations identified by the Examiner simply state that the pages can hold an item of recorded media. The Applicant submits that the limitations are clear and definite. To further clarify the limitations, the Applicant has amended each of these claims to specifically recite that the page has a structure that is adapted to hold the item of recorded media. These types of "adapted to" limitations are used frequently in patents in class 206. An informal search on the www.USPTO.gov patent search engine reveals 7,590 patents in class 206 using the phrase "adapted to" in the claims. In addition, MPEP § 2173.05(g) discloses that "adapted to" limitations are in compliance with § 112. The Applicant thus respectfully requests the Examiner to withdraw the rejection.

The Examiner rejected claims 1-4, 6, 10, 16, and 17 as being anticipated by Roze (4,823,950). The Examiner specifically recites element 60 of Fig. 4 as disclosing the spine recited in Applicant's independent claims. The Applicant respectfully traverses the rejection. The spine recited in Applicant's claims is disposed between the front and rear cover of the storage container. The spine referred to in each of the claims is the spine that connects the front cover to the rear cover as disclosed throughout the specification and in the drawings. The outer surface of this spine is visible when the cover is closed. To clarify the difference between the structure cited by the Examiner and the spine recited in the claims, the Applicant has amended each of the independent claims to recite that the cover includes an outer spine that has an outer surface and an inner surface with the outer surface of the outer spine being exposed for viewing. The Applicant has then amended each of the independent claims to recite that the page is connected to the

inner surface of the outer spine. The Applicant submits that these amendments clearly distinguish the Roze reference wherein the disc-holding pages are connected to element 60 which is described as a flexible securing member (column 3, lines 26-27) that is connected to the inner surface of the front and rear covers. The Roze reference thus specifically discloses and teaches that the disc-holding pages are spaced from the inner surface of the outer spine. The amended claims recite a different structure. In view of the differences in the newly amended independent claims and the Roze reference, the Applicant respectfully submits that the 102 rejection has been overcome.

The Examiner rejected claim 7 as being obvious in view of Roze in combination with House (5,791,468). The Examiner applies Roze in the manner described above and uses the House reference to disclose a cover fabricated from paperboard. The Examiner has not, however, cited any disclosure in either reference for disclosing, teaching, or suggesting the V-shaped page edges as specifically recited in independent claim 7. The Examiner contends that the V-shaped cross-section is merely an unpatentable change in cross-section. The Applicant respectfully submits that the addition of the V-shaped page edges provides a significant benefit that was not recognized in the art because the pages of the invention may be directly secured to the inner surface of the outer spine with an adhesive as described in Applicant's specification and shown in Applicant's drawings. References such as Roze use flat page ends that do not leave room for pockets of adhesive to secure the page edges. The invention recited in claim 7 provides improved page retention and better reliability than the prior art. The Applicant thus respectfully traverses the Examiner's contention that the V-shaped page edge is an unpatentable change in cross-section.

The Examiner has rejected the dependent claims under a variety of obviousness-type rejections using Roze as the primary reference. At this stage in the prosecution, the Applicant submits that each of the dependent claims is patentable based on the patentability of its independent claim contending that all of the secondary references cited by the Examiner failed to disclose recorded media

holding pages connected to the inner surface of an outer spine in the manner recited in the independent claims. The Applicant thus submits that no further response to these rejections is required at this time.

The Examiner rejected claim 19 as being obvious in view of Roze in combination with House and in further combination with Gelardi (4,793,480). The Applicant respectfully traverses the rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combines) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. MPEP § 2142.

The Applicant respectfully submits that the combination of references cited by the Examiner fails to meet the criteria of a *prima facie* case of obviousness. (First, all of the limitations of claim 19 related to the spine are not found in these references. Independent claim 19 has been amended to specifically recite that the page having the structure to hold two items of recorded media on opposite sides of the page is connected to the inner surface of the outer spine. The references cited by the Examiner fail to disclose, teach, or suggest this structure.) The addition of the House and Gelardi references to the Roze reference does not add the required disclosure. (The Examiner cites Gelardi as providing the teaching for a living hinge. The Applicant notes that the Gelardi living hinge is not disposed in the cover but is disposed in the page.) The Applicant thus respectfully traverses the Examiner's application of the Gelardi living hinge reference.

The Examiner rejected claim 20 as being obvious in view of the combination of Roze and Youngs (4,850,731). (The Applicant again submits that the Roze reference fails to disclose, teach, or suggest the page and spine arrangement now recited in amended claim 20. Independent claim 20 also specifically recites that a

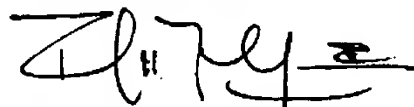
literature card is disposed between the page halves. Th Examiner cites Youngs as disclosing this feature. The Youngs' reference does not have substantially rigid pages that are formed from two halves with the literature card disposed between the halves as specifically recited in claim 20. The Youngs' reference discloses a flexible pocket wherein a literature card may be slipped between two flexible substrates. The Applicant thus respectfully submits that Young's fails to disclose, teach, or suggest the literature card and page half arrangement specifically recited in claim 20.

The Applicant has added new claims 21-23 and respectfully requests these claims to be examined.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims. Please call Fred H. Zollinger, III at (330) 244-1174 if th Examiner has any questions after this amendment.

Respectfully submitted at Canton, Ohio this 10th day of July, 2003.

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I hereby certify that this correspondence (Amendment B in application serial
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